Supreme Court of the United States

OCTOBER TERM, 1909.
No. [redacted] 1912.

CIMIOTTI UNHAIRING COMPANY AND JOHN W. SUTTON,

Petitioners,

vs.

AMERICAN FUR REFINING COMPANY AND MAX MISCHKE.

Brief for Petitioner on Application for Writ of Certiorari.

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CIMIOTTI UNHAIRING COMPANY and JOHN W. SUTTON *vs.* AMERICAN FUR REFINING COMPANY and MAX MISCHKE.	October Term, 1903. No.

Brief for Petitioners on Application for Writ of Certiorari.

This petition relates to the matter of the validity of claim 8 of U. S. Letters Patent No. 383,258, granted and issued May 22, 1888, to the petitioner, John W. Sutton. The petitioner Cimiotti Unhairing Company is the exclusive licensee under said letters patent. This petition is made necessary by reason of the fact that the Circuit Court of Appeals in the Third Circuit has refused to follow the repeated decisions of the Circuit Court of Appeals for the Second Circuit regarding this eighth claim of said patent, and while in words affirming the validity of the claim, has essentially declared it invalid by so limiting and restricting it as to deny protection to the real invention claimed therein.

The Conflict of Decisions.

The consequences of this conflict in the decisions of the two Circuit Courts of Appeals is that a

machine held to infringe the eighth claim in the Second Circuit and enjoined there may be removed across the Hudson River into the Third Circuit and there freely and openly used and protected. This is, in fact, what has practically been done by the defendants in this very case, and these defendants are now operating, with the sanction of the Circuit Court of Appeals for the Third Circuit, machines substantially identical with machines formerly built and operated by the defendant, Max Mischke, in New York, and there enjoined under the interpretation placed upon the patent by the Circuit Court of Appeals for the Second Circuit.

The enjoined machines referred to are those which were involved in the suit of these complainants against William A. Hulbert *et al.* in the Southern District of New York. William A. Hulbert was the president of the American Unhairing Machine Company, a New York corporation, which had already been enjoined for infringement of the eighth claim of the patent in suit, and driven out of business, after a long litigation involving several rehearings and an appeal to the Circuit Court of Appeals for the Second Circuit. The present defendant, Max Mischke, had been connected with that company as its foreman and built, or assisted in building, all its machines. The American Unhairing Machine Company, after it was enjoined, built certain other machines different from the enjoined ones, and purporting to be built according to the Lake British patent (which is the patent relied on by all infringers as an anticipation), and these so-called "Lake machines" were operated by William A. Hulbert at No. 93 Elizabeth street, New York City, said Mischke, as employee and foreman, doing the practical work of running the machines and keeping them in order (Record, pp. 15, 16, 25).

As soon as complainants obtained knowledge of

these facts, they began suit against Hulbert, and full proofs were taken and the case came on for final hearing before his Honor Judge Lacombe. Two types of machines were involved in that Hulbert suit—one a so-called "Hulbert one-brush Lake machine," the other a so-called "Hulbert two-brush Lake machine." Both were decided by his Honor Judge Lacombe to be infringements under the interpretation placed upon the eighth claim by the Circuit Court of Appeals for the Second Circuit, and both were enjoined (Record, pp. 25, 26, Exhibit K).

The so-called "Hulbert one-brush Lake machine" is substantially identical with the twenty-four machines operated by the defendants and complained of in this present suit. This fact appears clearly in the record in this suit.

The testimony of the defendant Max Mischke himself, given in this cause, clearly shows that those two machines are substantially alike.

In answer to Qs. 22–31 (Record, pp. 15, 16) Mischke testifies that before he became foreman for the defendant corporation he was foreman of the American Unhairing Machine Company, which company operated twenty-six machines built by his father, Karl Mischke, and some of them partly built by himself, all these machines having been enjoined and the business of the American Unhairing Machine Company broken up and disbanded.

In answer to Q. 41 (Record, p. 16) he states that the defendant corporation has three so-called "Lake machines," which were formerly in the possession of the American Unhairing Machine Company, and were operated at No. 93 Elizabeth street. These, as the testimony shows, are the Hulbert machines.

At p. 19 he testifies as follows:

> "Q. 77. What difference, if any, is there between these twenty-five machines at the

defendants' shop and the machines at Elizabeth street, N. Y.? I mean those you and I saw in the early part of this year?

A. They are all alike, with the exception that on two of the machines in Elizabeth street the outline of the plate was a little different, but the dimensions were alike.

Q. 78. I believe you call those machines which you got from the American Unhairing Machine Company Lake machines. Are these twenty-five machines at the defendants' place also Lake machines?

A. Yes."

Upon cross-examination by his own counsel he testified that the so-called "Lake machines" were built, some with one brush and some with two brushes, and that the machines with one brush worked better (Record, pp. 25, 26, x-Qs. 140–154).

It is submitted that from the foregoing it clearly appears that the one-brush Hulbert machines enjoined by his Honor Judge Lacombe are substantially identical in construction and operation with the machines used by defendants in this case. In his opinion finding the Hulbert machines infringements of the eighth claim of the patent in suit, Judge Lacombe states:

> "This patent has been repeatedly considered by the courts in this Circuit, has been held valid and given a liberal construction. * * * The construction given in former decisions is adhered to, * * * and within the interpretation already given to the eighth claim the new machines seem to infringe it."

This opinion was rendered after the decisions of the Circuit Court of Appeals interpreting the claim and following the various decisions below, and it

therefore clearly appears that under such interpretation the eighth claim of the patent in suit covers the machines of these defendants. There is therefore an absolute conflict between the two Circuit Courts of Appeals.

Photographs of the two-brush Hulbert machine are introduced by defendants at page 28 of the Record, but no photographs of the one-brush machine were ever made, and its construction, therefore, can be shown only by the testimony.

Further Conflict of Decisions:

THE CASE OF THE NEARSEAL COMPANY.

Another reason for presenting this petition is that the same questions, if not now decided, must necessarily be brought before this court in another suit.

The Nearseal Unhairing Company, on appeal to the Circuit Court of Appeals for the Second Circuit was adjudged an infringer by a divided court (Exhibit G). The principal question in that case was the equivalence of Sutton's card E, and the guard device used by the defendant, and on this point the court was divided. It is evident at a glance that on this question the decision in the Third Circuit is absolutely at variance with the prevailing decision in the Nearseal case.

The preliminary injunction granted against the Nearseal Company by Judge Thomas was suspended pending the appeal, upon the giving of a bond of twelve thousand dollars ($12,000) by defendant to complainants to cover the profits and damages from further operation of the infringing machines. On final hearing the cause was decided in favor of complainants, and on appeal the decision was affirmed (Exhibits I and J). The usual in-

terlocutory decree was entered and the accounting is now in progress.

It is beyond question that the Nearseal Company will never pay $12,000 without asking this court to decide the point, vital to its case, on which the two Circuit Courts of Appeals are at variance. The very same point is involved in this application, and this petitioner, what with its own bond and the Nearseal bond, has a direct pecuniary interest of $23,000 in the determination of this question.

The Patent in Suit.

The patent in suit (Record, p. 167) is for an improvement in unhairing machines by which all the actions are automatic and brushes take the place of bellows or an air blast in causing the separation necessary to remove the hairs. The patent in suit is directed to the unhairing of seal and other skins, and for this reason various subsidiary devices are provided, which are more especially adapted for certain skins and may be dispensed with when other skins are treated. For instance, in the case of seal skins certain portions of the pelt about the flippers are difficult to handle and specific mechanism is provided, which the patentee himself says may be put out of operation or dispensed with when these parts are not to be treated. Certain other portions of the mechanism have been found by experience not to be absolutely necessary in the treatment of certain skins, and in the case of coney skins it has been found that only the elements mentioned in the eighth claim of the patent in suit are really necessary to constitute an operative machine. These elements are set forth in that claim as follows:

1. A fixed stretcher-bar.

2. Means for intermittently feeding the skin over the same.

3. A stationary card above the stretcher-bar.

4. A rotary separating brush below the same; and

5. Mechanism, substantially as described, whereby the rotary brush is moved upward and forward into a position in front of the stretcher-bar.

It is evident that the words "above" and "below" and "upward and forward" are merely relative and that it must also be immaterial whether the separating brush is moved to and from the edge of the stretcher-bar or the edge of the stretcher-bar is moved to and from the separating brush, provided that the contact between the two is made in substantially the same way, with substantially the same function and result. This has been uniformly recognized by the Courts in the Second Circuit, although the Court of Appeals for the Third Circuit has apparently taken a different view in these respects.

The fixed stretcher-bar, over which the pelt is stretched, is old. The intermittent feeding of the pelt over this bar is old. The use of a fixed guard device of some sort on the side of the stretcher-bar from which the pelt is fed over the edge is also old. Sutton speaks of this side as the upper side, because in his machine the bar is placed horizontally and the pelt is fed from above over the edge downward. In this litigation, however, to avoid confusion in cases where the stretcher-bar is placed vertically, this side is called the "on-side" of the bar and the lower side, or opposite side, or side toward which the pelt travels, is called the "off-side." The really new means in Sutton's invention are the fourth and fifth elements of the claim, and the essential novelty of the invention has been uniformly recognized in

in the Second Circuit to reside in the motion given to the rotary brush, whereby it is enabled to be what Sutton calls it—a true "separating" brush, and is enabled to brush the fur down in such manner and to such an extent that it shall stay down out of harm's way long enough for the hairs to be removed. Sutton was the first to accomplish this automatically and by means of brushes. This has repeatedly been decided by the Second Circuit. The only prior successful machines were blast machines, so-called, employing an air blast for this purpose. No other successful brush machine is proved ever to have existed, and such patents of the prior art as have ever been presented to the Courts have on thorough investigation been proved to be mere paper patents, which were either unintelligible or inoperative and never resulted in an effective machine or had any practical influence upon this art. There has never been any practical doubt that the machines built and operated under the patent in suit were the first and only really successful unhairing machines employing brushes in place of an air blast. This patent has been the foundation of a successful industry and the invention has proved to be a pioneer invention. The practical question which has been presented to the Courts throughout the litigation on this patent is whether this eighth claim shall be so interpreted as to cover the real invention which the patent shows, and which the operation of the patented machines shows was practically a pioneer invention. The somewhat unfortunate phraseology of the claim has been the great subject of dispute, and the defendants have generally sought to limit the monopoly by every word of apparent limitation found in the claim, although nothing in the specification or the prior art necessitates such limitation.

Nothing in the patent or the prior art necessitates a "fixed" stretcher-bar. Sutton has a fixed bar

because his separating brush and knives are movable. In the Lake British patent we find a movable stretcher-bar because the rotary brush and knives are there fixed; but Lake, many years before Sutton, pointed out that it was immaterial which part was fixed and which movable, and the Courts have never until this present case had any difficulty with this point.

Sutton specifies a *fixed card* on one side of the stretcher-bar. As this card is to be constantly in contact with the pelt, it would of course be "fixed" if the stretcher-bar is fixed. Sutton specifies a card because in his judgment that is the *best form* of a guard device. The prior patentees, however, had used a guard device on the side of the bar from which the pelt was fed, and in fact most of the prior patents show guard devices on both sides of the bar. In the Lake patent the guard device is the edge of a so-called "pressure plate"; in the Covert patent it is the back of a knife blade; and in other patents so-called gates or wipers are utilized wholly or partially for a like purpose. Nothing in the patent or in the prior art forbids the use of a solid instead of a toothed guard device, and if such guard device proves effective with the combination of the eighth claim, nothing in the patent or prior art forbids it to be considered as an equivalent.

Sutton specifies a rotary brush "below" the stretcher-bar; but this, of course, means simply that it is to be on the opposite side of the bar from that where the guard device is fixed.

Sutton specifies and describes mechanism for moving this rotary separating brush to and from the edge of the fixed stretcher-bar. Nothing in the patent or in the prior art forbids, and the prior Lake patent points out and justifies as equivalent, the transferrence of the motion from one to the other and the use of a movable stretcher-bar with a

fixed brush. Of course, means for removing the hairs are implied as an element of the claim. This has never been questioned in any of the suits on this patent and the courts have never wasted any time over this point.

The essence of the Sutton invention, as the courts have repeatedly decided, consists in the action of the rotary brush upon the pelt, whereby an effective separation is made and the soft fur is brushed long enough and far enough down to insure its remaining down and out of harm's way during the brief period when the knives act.

The Court of Appeals for the Second Circuit, in the case against the American Unhairing Machine Company, says:

> "The prior art is within unusually circumscribed limits. It is conceded on all sides that nothing found there affects the patent in suit, except the English patent to Lake of 1881, the United States patent to Covert of 1884, and the machine made by Covert in 1886 and introduced in evidence as the 'Covert machine.'
>
> "That both Lake and Covert had in mind an automatic brush machine is evident, but it is equally clear that neither succeeded in embodying his idea in a practical working mechanism."

In the same case the Court decided that the Lake patent was unintelligible, and said:

> "For nearly twenty years it remained nothing but an ambiguous description of incomprehensible drawings. It emerged from oblivion solely to meet the exigencies of this litigation. * * * Is not the presumption almost conclusive that it was not used because it was not usable?"

The so-called "Covert *machine*" is not in this case. Practically nothing but the Lake and Covert *patents* are relied upon. No testimony was taken for the defence. Nevertheless the Court of Appeals for the Third Circuit, in justifying its conclusion that the defendants do not infringe, finds its necessary to insist upon every word of specific reference in the claim and to insist that defendants have not a "fixed stretcher-bar" or a "card" or a "movable brush" or "means for moving the brush."

Further Conflict of Decisions.

The eighth claim of the patent in suit mentions as one of the elements of the claim "a stationary card above the stretcher-bar." This card and its function and action are described at various places in the specification. In lines 26–38, on page 2 of the specification, this card E is described as being attached to the ends of the stretcher-bar by means of thumb-screws, not shown. "The points of the teeth of the card E are close to, but do not touch the surface of the skin, so that the hair and fur are both straightened as the skin is fed forward." This describes one of the functions of the card, which is to comb out or strengthen the fibers of hair and fur, in order to disentangle them to some extent and thereby lessen the work imposed upon the rotary separating brush, which is to make the part. "The teeth of the card E hold down the fine fur, but permit the stiff hairs to stand up between the teeth, owing to the slow forward movement of the skin, which gives the hairs sufficient time to so adjust themselves." This passage describes a further function and action of the card, namely, its action while the pelt is being intermittently fed forward before the separating and cutting actions take place. During this period of time the teeth of the

card hold down the fine fur, but at the same time permit the stiffer hairs to rise somewhat between the teeth, thereby preserving their resiliency, which is afterwards to be availed of in making the separation.

But the primary function of this card is described on page 3 of the specification, lines 21–26, as follows:

> "The card is set back from the edge of the stretcher-bar to a distance a little more than one-half of the length of the fur, for the purpose of holding the fur and preventing it from moving forward *until the forward motion of the skin takes place*,"

that is, during the time when the skin or pelt is stationary (*i. e.*, between the intermittent movements or feeds and while the separating and cutting actions are taking place).

The function of the card is to *hold back* the fur and prevent its creeping forward by reason of the tension on the skin, or by its own slight resilience, so far as to interfere with the parting then being made by the rotary brush F preparatory to the cutting, and until the cutting has taken place and the next forward movement of the skin takes place.

It is evident at a glance that this is the primary and necessary function of the card, and that this function may equally well be served by any device which shall press upon the fur at that point and hold it back out of the "part." The other functions of the card are subsidiary and secondary, and serve merely to lessen somewhat the work imposed upon the rotary separating brush. The success of defendants' machines, which use a solid guard or so-called "pressure-plate" in place of a card, proves that the precise construction of the guard

device set forth in the patent is not essential to the operativeness of the eighth claim, and it is evident that the eighth claim sets forth efficient means for securing the desired result, even if a solid guard or pressure-plate be employed in place of the card E.

That a solid bar or pressure-plate may effectively be used in place of the card E, and that it is a substantial equivalent for such card in the combination stated in the eighth claim of the patent in suit, has been repeatedly recognized during the litigations arising under this patent and is clearly shown by prior patents relating to this art. In the case of these complainants against the Nearseal Unhairing Co., the opinion of Judge Thomas, reported in 113 Fed. Rep., 588 (Exhibit E), shows that the defendant in that case used in place of the card E a roller, which was substantially a stationary bar, to press down the fur and hair alike. The Court said:

> "Upon the argument the Court, in answer to its inquiries, did not discover that any different result was obtained from the failure of the complainants' device to press down the long hairs with the fur, or that the defendant added anything to the utility of its machine by pressing down the fur and the long hair alike. The use of the roller, therefore, is a simple equivalent for the card used by the complainants."

On appeal the Circuit Court of Appeals, in its opinion reported in 115 Fed. Rep., 507 (Exhibit G), says:

> "The appellant, in place of the card E of the patent, uses an emery-covered roller which revolves so slowly that for all practical purposes it may be called stationary. This roller, by stretching the pelt, gives additional

> resiliency to the hair, permitting it to spring up while the fine fur continues to be pressed down, to some extent, as it is fed over the edge of the bar. In short, it does what the Sutton card does, and in substantially the same way * * * The appellant's emery-covered roller is an equivalent for the card of the patent."

Upon final hearing and further appeal (Exhibits I and J) this view was adhered to.

In the case of these complainants against the Comstock Unhairing Co., *et al.*, Judge Coxe, in his opinion reported in 115 Fed. Rep., 524 (Exhibit H), says:

> "The defendants' machine * * * has an equivalent for the third element of the claim, namely, 'a fixed card above the stretcher bar.' This proposition, if not admitted, is certainly not seriously disputed. Indeed, in defendants' brief a 'stationary card' and a 'pressure-plate or guard device' are spoken of as synonymous terms and are treated as well recognized equivalents."

The Lake patent, so much relied on by defendants, shows and describes a solid guard or "compression plate" K^2, which is spring-held against the pelt in the same position as the card E of Sutton, and which operates in the same way to hold back the fur until the forward motion of the skin takes place. The Covert patent, offered by defendants, utilizes one of the knife blades for this same purpose.

Nevertheless in the case at bar the Circuit Court of Appeals for the Third Circuit (Exhibit O), states:

> "The respondents have found means to unhair pelts by the *total omission* of the sta-

tionary card with its teeth and preparatory work, *an essential element of Sutton's eighth claim.* The fur and hair are neither straightened, separated or subjected to any such preparatory card-work in the respondents' device. They use a repression bar of the same general type shown in the repressing blade of the Covert patent of 1884, and the compression plate of the Lake English patent of 1881."

It will be seen, therefore, that the Court here holds that the teeth and preparatory work of Sutton's card E are essential elements of his invention, and that a solid guard device cannot be accepted as an equivalent for the card E. This is directly at variance with the decision in the Nearseal case.

Resumé.

In the Second Circuit, the eighth claim of the patent in suit is valid under a liberal construction, and one which preserves the real invention.

In the Third Circuit it is valid only under the narrowest possible construction, and one which defeats and destroys the real invention.

In the Second Circuit, the so-called "Hulbert One-Brush Lake Machine," built by the defendant Mischke, is enjoined.

In the Third Circuit the same machine is free.

In the Second Circuit the machines of the Nearseal Unhairing Company are enjoined.

In the Third Circuit they may be freely operated.

In the Second Circuit the roller-guard of the Nearseal Company and the pressure-plate of the Com-

stock Company are the equivalents of Sutton's card, E.

In the Third Circuit they are not.

In the Second Circuit it is immaterial whether the brush moves to the stretcher-bar or the stretcher-bar to the brush.

In the Third Circuit it is not.

Under the construction given to the claim in the Third Circuit every machine hitherto enjoined in the Second Circuit may be freely operated if carried across the Hudson River.

Conclusion.

The petition for certiorari should be granted.

Respectfully submitted,

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New York, Jan. 20, 1904.